ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention I," drawn to a portable ECG device, and corresponding to claims 37–51

REMARKS

The Examiner has improperly identified two 'inventions' in the pending claims. The Examiner's classification of the 'inventions' includes Group I consisting of claims 37–51 drawn to a portable ECG device and classified by the Examiner in class 600, subclass 523, and Group II consisting of claims 52–61 drawn to a remote/local ECG monitor and classified by the Examiner in class 600, subclass 509.

In setting forth the restriction the Examiner states, "Inventions II and I are related as combination and subcombination." The Examiner further states that, "Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c))." Continuing, the Examiner states that, "[i]n the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the monitor to produce 12 lead ECG data" and that "[t]he subcombination has separate utility by itself, such as a portable ECG monitor not requiring a second ECG monitor providing ECG signals in human discernable form, but a stand-alone system requiring one monitor to process the signals."

A restriction under MPEP §806.05(c) must satisfy three (3) requirements. The first requirement is that the combination as claimed does not require the particulars of the subcombination as claimed for patentability (to show novelty and obviousness). *See* MPEP §806.05(c) The Examiner's statement that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the monitor to produce 12 lead ECG data" infers that the patentability of claim 37 is based on producing 12 lead ECG data. Such is not the case. Specifically, the patentability of claim 37 is based on the entirety of the elements called for in the claim and the interrelation therebetween. Claim 37 calls for, in part, an ECG monitor adapted to be connected to a lead wire assembly. Likewise, claim 52 calls for an ECG monitor having multiple leads to acquire ECG signals from a

patient. Claim 37 also calls for a wireless communication interface to receive patient ECG data from the ECG monitor and transmit patient ECG data to a healthcare provider. Similarly, claim 52 calls for a remote communication interface to receive ECG signals from a remote ECG monitor and transmit the ECG signals to a centralized facility. The similarities between claims 37 and 52 are clearly apparent. It is equally apparent that the Examiner has merely indicated a three (3) word distinction between claims 37 and 52 without a substantive review of what is called for in each of the respective claims in an effort to support the imposed restriction.

Using the nomenclature of MPEP §806.05(c), it is apparent that claims 37 and 52 are related as AB_{SP}/B_{SP}. Absent the 12 lead ECG data in claim 52, in light of the similarities between claim 37 and 52 recited above, it is apparent that the separately claimed subcombination B_{SP} constitutes the distinguishing features of the combination AB_{SP} as claimed.

During the previous examination, the Examiner stated on pages 2 and 3 of the Advisory Action mailed April 16, 2003 that producing 12-lead ECG data is obvious, and therefore not patentable, over the art of record. Therefore, the Examiner's previous position is that there is no patentable distinction in producing 12-lead ECG data. The Examiner is taking contrary and directly opposing positions. Based on the file history and for at least for the reasons set forth above and in accordance with MPEP §806.05(c)(II), a requirement for restriction cannot be sustained, even if the subcombination has separate utility.

In an attempt to satisfy the second requirement for restriction under MPEP §806.05(c), that the subcombination can be shown to have utility either by itself or in other and different relations, the Examiner states that "the subcombination (claim 37) has separate utility by itself, such as a portable ECG monitor not requiring a second ECG monitor providing ECG signals in human discernable form, but a stand-alone system requiring one monitor to process the signals." Contrary to the Examiner's assertion, neither claims 37 nor 52 of the present application call for a second ECG monitor. Claim 52 calls for a local ECG device connected to a local communication interface to receive ECG signals and provide ECG signals in human discernable form. That is, the local ECG device is not a second ECG monitor. Claim 52 calls for a remote ECG monitor in the first clause of the claim. The local ECG device recited in the last clause of the claim is not a monitor having multiple leads to acquire ECG signals from a patient, but is a device in communication with the ECG monitor. The Examiner's statement that the subcombination has separate utility by itself by not requiring a second ECG monitor is merely self serving, and any

support therefore is not found in the present claims as none of the claims require a second ECG monitor. That is, the Examiner's statement provides no distinction between the claims of Group I or Group II. As such, the Examiner has failed to satisfy the second requirement for restriction as required under MPEP §806.05(c).

A third requirement for restriction under MPEP §806.05(c), in addition to the two-way distinctiveness, is that the Examiner provide reasons for insisting on restriction [are necessary], i.e., separate classification, status, or field of search." The Examiner states that "because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper." Applicant respectfully disagrees. The Examiner classified Group I, drawn to a portable ECG device, in class 600, titled-Surgery, and subclass 523, titled-Signal Display or Recording. The Examiner classified the claims of Group II in class 600 and subclass 509, titled Detecting Heartbeat Electric Signal. Claim 37 calls for a processor to process ECG signals from a lead wire assembly and produce standard 12-lead ECG data representative of cardiac condition of the patient. Claim 37 further calls for, an information management system connectable to a data link port of the ECG monitor to maintain ECG monitoring during patient transport to a health care facility, and having data storage to maintain an ECG history that is downloadable at the health care facility. Similarly, claim 52 calls for a remote ECG monitor having multiple leads and multiple channels to acquire ECG signals from a patient and further for a local ECG device connected to a local communication interface to receive the ECG signals and provide the ECG signals in human discernable form and a data port connectable to a data storage device of the remote ECG monitor to allow direct transfer of data therebetween. Claims 37 and 52 each individually include elements directed to "detecting heartbeat electric signal" and "signal display or recording." As such, it is apparent that the claims of Group I and Group II should each be classified into the class and subclasses identified by the Examiner. Therefore, not only has the Examiner failed to substantively support each of the distinctness criteria of MPEP §806.05(c) but has also failed to differentiate the subject matter of that which is called for in the claims of Group I and Group II.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

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Dated: July 8, 2004
Attorney Docket No.: GEMS8081.040

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